REMARKS

I.   Overview

These remarks are set forth in response to the Latest Non-Final Office Action. Presently, claims 15-29 are pending in the Patent Application. Claims 1-14 have been cancelled. Claims 15, 20, and 25 are independent in nature. In the Latest Non-Final Office Action, claims 25-29 have been rejected under 35 U.S.C. § 101. The specification has been objected to. Further, claims 25-29 have been rejected under 35 U.S.C. § 103(a).

In response, *Applicant has amended claim 25 to address the rejection under 35 U.S.C. § 101. Applicant has also amended claims 20-24 to address the objection to the specification. Although Applicant disagrees with the art rejections, Applicant has slightly modified the language of the independent claims in an effort to even more clearly define the Applicant's invention and to facilitate expeditious prosecution. No new matter has been introduced.*

II.   Rejections Under 35 U.S.C. § 101

On page 2 of the Latest Non-Final Office Action, Examiner rejects claims 25-29 under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Specifically, Examine asserts that the product and medium as recited in claim 25 can include signals per se and as such the claim is not limited to non-transitory, statutory subject matter. Yet, as amended, claim 25 recites a storage medium. The notion that a storage medium recites statutory subject matter is supported by a recent Decision for the Board of Patent Appeals and Interferences (hereinafter the Honorable Board).

Specifically, reference is made to the non-precedential opinion of Ex parte Mehta (Appeal No. 2008-004853). In reversing a rejection under 35 U.S.C. § 101, the Honorable Board held the following:

> We agree with Appellants (App. Br. 10-11; Reply Br. 1-3), however, that, contrary to the Examiner's contention, claims 29-42 necessarily include a storage medium since the language of independent claim 29 recites an "article comprising a storage medium...." Further, the language of independent claim 29, which recites that the storage medium stores computer-executable instructions which are readable and cause a computer to perform the listed operations, establishes the requisite structural and functional interrelationships between the computer and the stored instructions which permit the computer's functionality to be realized. See In re Lowry, 32 F.3d 1579, 1583-84 (Fed. Cir. 1994). (emphasis added)

In this regard, the Examiner is directed to M.P.E.P. § 2106.01, which states:

> When functional descriptive material is recorded on some computer-readable medium, it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized.

Independent claim 25 recites a "computer program product comprising a computer readable storage medium having stored therein computer usable program code." Claim 25 also recites that the computer usable program code is used by a machine (i.e., a computer hardware system) to perform various steps of a method. Thus, the use of technology (i.e., a computer usable storage medium and a computer hardware system) permits the function of the functional descriptive material (i.e., computer usable program code) to be realized.

Even further, a "storage medium" is well-known to mean "any device or recording medium into which data can be copied and held until some later time, and from which the entire original data can be obtained." (answers.com) By comparison, a signal cannot hold data until some later time due to its transitory nature. This clearly indicates that a "storage medium" is not a transitory medium and thus is statutory subject matter. For the above-described reasons, Applicants respectfully solicit withdrawal of the imposed rejection of claim 25 under 35 U.S.C. § 101.

III.   Objections to the Specification

On page 2 of the Latest Non-Final Office Action, Examiner objects to

the specification as failing to provide proper antecedent basis for the

computer hardware system of claims 20-24. Although Applicant disagrees

with the objection, Applicant has amended claim 20 to recite a "computer

system."

IV.   Rejections Under 35 U.S.C. § 103

On pages 3-7 of the Latest Non-Final Office Action, Examiner rejects

claims 15, 19-20, 24-25, and 29 under 35 U.S.C. § 103(a) as being

unpatentable over U.S. Patent No. 6,421,674 to Yoakum et al. (Yoakum) in

view of U.S. Patent No. 7,730,019 to Graham; and rejects claims 16-18, 21-

23, and 26-28 under 35 U.S.C. § 103(a) as being unpatentable over Yoakum

and Graham further in view of U.S. Patent No. 6,247,141 to Holmberg.

With respect to the Examiner's determination of obviousness, Section

2141 of the Manual of Patent Examining Procedure (M.P.E.P.) sets forth

guidelines intended to assist personnel of the United States Patent and

Trademark Office in making a proper determination of obviousness under 35

U.S.C. 103, and to provide an appropriate supporting rationale in view

recent judicial developments in regard to 35 U.S.C. § 103. Included as part

of M.P.E.P. 2141 are the "Examination Guidelines for Determining

Obviousness Under 35 U.S.C. 103 in View of the Supreme Court Decision

in KSR International Co. v. Teleflex Inc.," 73 Fed. Reg. 57,526 (2007)

(hereinafter the Examination Guidelines). Section III of M.P.E.P. 2141 is

entitled "Rationales To Support Rejections Under 35 U.S.C. 103."

Referring to Section III of the Examination Guidelines, the following

is a list of rationales that may be used to support a finding of obviousness

under 35 U.S.C. § 103:

> **(A) Combining prior art elements according to known methods to
> yield predictable results;**
> (B) Simple substitution of one known element for another to obtain
> predictable results;
> (C) Use of known technique to improve similar devices (methods, or
> products) in the same way;
> (D) Applying a known technique to a known device (method, or product)
> ready for improvement to yield predictable results;
> (E) "Obvious to try" - choosing from a finite number of identified,
> predictable solutions, with a reasonable expectation of success;
> (F) Known work in one field of endeavor may prompt variations of it for
> use in either the same field or a different one based on design incentives or
> other market forces if the variations would have been predictable to one of
> ordinary skill in the art;
> (G) Some teaching, suggestion, or motivation in the prior art that would
> have led one of ordinary skill to modify the prior art reference or to
> combine prior art reference teachings to arrive at the claimed invention.

Upon reviewing the Examiner's analysis in the Latest Non-Final Office

Action, the Examiner appears to be employing rationale (A). If the

Examiner is not relying upon rationale (A), Applicant requests that the

Examiner clearly identify the rationale, as described in the Examination

Guidelines, being employed by the Examiner in rejecting the claims under

35 U.S.C. § 103.

    With respect to rationale (A), the Examination Guidelines set forth a

precise process for which the Examiner must follow in order to establish a

prima facie case of obviousness under 35 U.S.C. § 103(a). Specifically, to

reject a claim based on this rationale, Office personnel must resolve the

Graham factual inquiries. Thereafter, Office personnel must then articulate

the following:

> (1) **a finding that the prior art included each element claimed**,
> although not necessarily in a single prior art reference, with the only
> difference between the claimed invention and the prior art being the lack
> of actual combination of the elements in a single prior art reference;
> (2) a finding that one of ordinary skill in the art could have combined the
> elements as claimed by known methods, and that in combination, each
> element merely would have performed the same function as it did
> separately;
> (3) a finding that one of ordinary skill in the art would have recognized
> that the results of the combination were predictable; and
> (4) whatever additional findings based on the Graham factual inquiries
> may be necessary, in view of the facts of the case under consideration, to
> explain a conclusion of obviousness.

In articulating a finding that the prior art included each element claimed in a

rejected claim, must establish a proper claim construction and then compare

the properly construed claim to the prior art."[1]   It is the position of

Applicant that under M.P.E.P. 2141 and rationale (A) of the Examination

Guidelines set forth therein, Examiner has not adequately articulated a

finding that the prior art included each properly construed element claimed

with the only difference between the claimed invention and the prior art

being the lack of actual combination of the elements in a single prior art

reference.

In this regard, claim 15 recites a method of operating a computer

system which includes an application client, a first application server

configured to process requests of the application client, a second application

server configured to process requests of the application client, and a

database shared by the first and second application servers. For the

convenience of the Examiner, claim 15 is reproduced herein as follows:

> 15.   A method of operating a computer system, wherein the computer
> system comprises an application client, a first application server
> configured to process requests of the application client, a second
> application server configured to process requests of the application client,
> and a database shared by the first and second application servers, the
> method comprising:
>   detecting, by the first application server, that the shared database is
> not accessible by the first application server;

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[1] Medichem, S.A. v. Rolabo, S.L., 353 F.3d 928, 933 (Fed. Cir. 2003) (internal citations
omitted).

receiving, by the first application server, a request from the application client to the first application server;

forwarding, by the first application server, the request to the second application server, while the shared database is not accessible by the first application server;

receiving, by the second application server, the request from the first application server;

accessing, by the second application server, the shared database;

generating, by the second application server, a response to the request;

forwarding, by the second application server, the response to the first application server while the shared database is not accessible by the first application server;

receiving, by the first application server, the response from the second application server; and

forwarding, by the first application server, the response to the application client.

Integral to claim 15 (and also claims 20 and 25) is the forwarding of a client request from a first application server to a second application server when the database shared by the first application server and the second application server is not accessible by the first application server. Applicant submits that this key concept or limitation is not disclosed by any of the cited references or any combination thereof.

Notwithstanding, Examiner disagrees and asserts the contrary in citing to col. 4, lines 23-51 of Yoakum as disclosing all Applicant's claimed limitations of claim 15 except for the step of "detecting, by the first application server, that the database is not accessible by the first application

server and the various actions performed while the database is not

accessible". For the convenience of the Examiner, col. 4, lines 23-51 of

Yoakum is reproduced below:

> In addition, proxy server 208 can receive messages from gateway 204 and perform a first database lookup based on information contained in the first message. As used herein, the phrase "database lookup" is intended to include a lookup in a database of records stored in computer memory or equivalent logical processing where desired output information is determined from input information. If proxy server 208 has the requested information, proxy server 208 can respond to the message from gateway 204 by sending a response containing the results of the lookup to gateway 204. However, proxy server 208 might not have the requested information in its local database. In this case, results from the first database lookup can include the location of a second database where the desired information is located. Proxy server 208 then proxies the first message, formulates a second proxiable protocol message, and sends the second message to another proxy server that contains the requested information or the address of another server that includes the requested information. For example, proxy server 208 can send the second message to proxy server 210 that has access to a subscriber database (not shown) containing the requested subscriber information. In a preferred embodiment, the second message includes return route information so that proxy server 210 will return a response to proxy server 208. If proxy server 210 has the desired information, proxy server 210 responds to proxy server 208 with the desired information. Proxy server 208 sends the information to gateway 204. Gateway 204 extracts the information and communicates the information to SSP 202.

In consideration of col. 4, lines 23-51 of Yoakum, it is noted that in Yoakum

each proxy server has its own local database and the proxy servers do not

share a database. This can be clearly seen in Fig. 5 of Yoakum, which is

reproduced below:
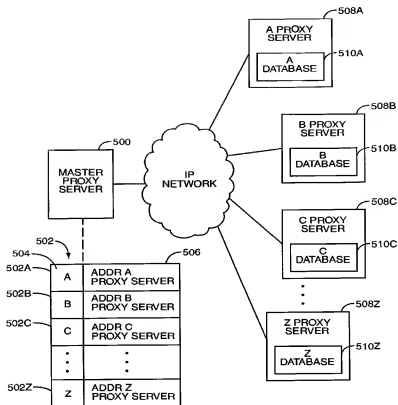
FIG. 5

Further, it is noted that in Yoakum the proxy server 208 sends a message to the proxy server 210 only when the proxy server 208 does not have the requested information in its local database while the proxy server 210 has the requested information in its local database. Accordingly, the teachings of Yoakum differ from those claimed by Applicant's in which the first server forwards the client request to the second server when the first server cannot access the shared database.

Importantly, Graham does not cure the deficiencies of Yoakum as discussed above. Graham discloses a system and method that performs data analysis, such as economic forecasting, in accordance with the configured needs of one or more users. Graham also does not disclose the inventive concept of the Applicant's invention, namely forwarding the client request from the first server to the second server when the first server cannot access the database shared by the first server and the second server. Further, Graham does not teach what Examiner asserted on page 4 of the Latest Non-Final Office Action. The Examiner's assertion is reproduced below:

> Yoakum fails to teach the limitation further including detecting by the first application server that a database is not accessible and the first and second servers performing various actions while the database is not accessible.
>
> However, Graham teaches the use of a data analysis system detecting that a database is not accessible and the handling of an unreadable database (col. 4, lines 43-51, col. 11, lines 21-22, col. 11, line 60 – col. 12, line 11).

For the convenience of the Examiner, col. 4, lines 43-51, col. 11, lines 21-22, and col. 11, line 60 – col. 12, line 11 of Graham are reproduced below:

FIG. **1** presents a simplified illustration for an exemplary overall environment **10** in which the present invention may be advantageously practiced. In this embodiment, the data analysis system **20** of the present invention includes an ana-
45 lytical process **210** with associated local databases **212**, a data collection process **220** with an associated local database index **222**, and a user interface process **230** with associated local user information **232**. This is a simplified functional depiction of the data analysis system **20**; an exemplary physi-
50 cal depiction of a computer platform for supporting the data analysis system **20** appears later herein.

and characteristics of a given database.   20

If the current database **34** is unreadable (block **622**), processing continues with logic "A" that is detailed in FIG. 6B. If

Logic group A, detailed in FIG. **6B** illustrates exemplary 60 provisions for handling any unreadable databases **34** encountered during searching. As noted, the unreadable condition may result from certain access controls placed on the current database **34**, as might be applied to a commercial pay-for-use database. Or, the condition might result from the database **34** 65 being in an unknown format. If an unreadable database **34** is encountered (block **622**, FIG. **6A**), the data analysis system **20** determines if the database **34** has been previously indexed (found before) (block **640**). Information stored in the database or data series indexes **222** and **224**, respectively, may be used to make this determination. If this is a newly encoun-
5 tered unreadable database **34**, the data analysis system stores location information for the current database **34** in the database index **222** (block **650**), sets the appropriate flags and indicators, and stores any helpful problem information (block **652**). Processing then continues with checking for more data-
10 bases at the current computer system **32** (block **634**, FIG. **6A**).

First, Applicant believes that "unreadable" is different from "not accessible"

in the sense of the Applicant's invention as the term "unreadable" means

"unable to be read" but does not foreclose an opportunity to access, while "not accessible" does not require "unreadable". Second, it is noted that in Graham when an unreadable database is encountered, the data analysis system determines if the database has been previously indexed (found before). In comparison, in the Applicant's invention when the shared database is not accessible by the first server, the client request is forwarded from the first server to the second server that can access the shared database.

In view of the forgoing, Applicant believes that Examiner has failed to find that the prior art included each element claimed. Accordingly, Applicant submits that the Examiner has not established a prima facie case of obviousness.

IV.   Conclusion

Applicant respectfully requests the withdrawal of the objection to the specification and the rejections under 35 U.S.C. §§ 101 and 103(a) owing to the amendments and foregoing remarks. The Applicant requests that the Examiner call the undersigned if clarification is needed on any matter within this Amendment, or if the Examiner believes a telephone interview would expedite the prosecution of the subject application to completion.

Respectfully submitted,

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